

Neifeld Docket No: CAT/29US-SCROCO

Application/Patent No: 09/401,939

USPTO CONFIRMATION NO: 5333

File/Issue Date: 9/23/1999

Inventor/title: Scroggie/System and Method for Providing Shopping Aids and Incentives to Customers Through a Computer Network

Examiner/ArtUnit: Janvier/3622

BPAI DOCKET NO: 2008-4478

EX PARTE SCROGGIE

**37 CFR 1.7(c) FILING RECEIPT AND TRANSMITTAL LETTER WITH
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1. **THE COMMISSIONER IS HEREBY AUTHORIZED TO CHARGE ANY FEES
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2. **FEES (PAID HEREWITH BY EFS CREDIT CARD SUBMISSION) \$:**

A. CLAIMS FEES

0.00 \$ - (claims previously paid for; currently present; \$50 per addl. claim over 20.)

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REQUEST FOR REHEARING**

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USPTO CHARGES: \$ 0 CLIENT BILLING MATTER: BANK ACCOUNT/Check: G/L ACCOUNT: 5010	FIRM CHARGES: DESCRIPTION: LAWYER: BTM
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DATE: 5-11-2010

SIGNATURE: /RichardNeifeld#35,299/

RICHARD NEIFELD

Printed: May 14, 2010 (4:57pm)

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37 CFR 41.52 REQUEST FOR REHEARING

The appellant requests rehearing of the decision on appeal dated May 4, 2010.

I. SUMMARY

37 CFR 41.52 requires this request for rehearing:

state with particularity the points believed to have been misapprehended or overlooked by the Board.

It also notes that:

Arguments not raised in the briefs before the Board and evidence not previously relied upon in the brief and any reply brief(s) are not permitted in the request for rehearing except as permitted by paragraphs (a)(2) and (a)(3) of this section.

Accordingly, the following sections identify (1) errors of law misapprehended or overlooked by the panel in the decision. In summary, these errors are as follows:

1. Incorrect standard summary of the standard of review.
2. Incorrect conclusion as to the law of claim construction.
3. Improper reliance upon an alleged dictionary definition
4. Adjudication not in compliance with precedential legal requirements by failing to address in the decision points raised in the brief regarding the specification's definition of a "personal computer"
5. Incorrect conclusion of law, relying upon items 1-4, concluding that the claimed "personal computer" reads on Nichtberger's "CDR unit 20 [which in the only physical embodiment disclosed in Nichtberger] may comprise a five foot high metal enclosure, on the front panel of which are mounted a color video monitor 88 (FIG. 5) with a touch screen sensor 90, a magnetic stripe card reader 92 and a coupon selection list printer 94, all within easy reach of a standing adult."

In the big picture, the appellant's brief explained why the claimed personal computer was different from Nichtberger's CDR 20. However, the decision on appeal ignored that section of the brief that construes "personal computer" in view of our specification. Rather than reiterating those arguments here, as required by 41.52, the appellant points to the legal errors, why they are not harmless, why the panel's decision would be reversed on appeal. The appellant leaves it to the panel to review the arguments in the brief while applying the proper legal standards to a decision on rehearing.

Appellant cites below to evidence impugning the accuracy of the alleged dictionary definition relied upon in the decision. BPAI precedent indicates that the appellant's reliance upon, including quotation and citation to an URL, are not new evidence and therefore are not barred in this paper. Accordingly, this request is admissible notwithstanding those citations. On that issue, see my article at: "Will the Board of Patent Appeals and Interferences Rely Upon Dictionary Definitions Newly Cited in Appeal Briefs? Answer: It Depends" available at: [http://www.neifeld.com/CanBPAIAppealantsNewlyCiteToDictionaryDefinitionsInAppealBriefs_8-24-2008%20\(3\).pdf](http://www.neifeld.com/CanBPAIAppealantsNewlyCiteToDictionaryDefinitionsInAppealBriefs_8-24-2008%20(3).pdf); the decision dated 7/22/2008 in application 09/401,939; and the subsequent decision dated 8/5/2009 by the CAJ in In re Reexamination 90/006,707 authorizing entry of the reply brief and its attached exhibits.

Finally, since requiring the panel to provide a copy of the evidence it relied upon, the alleged dictionary definition, of "personal computer", is procedural and therefore discretionary with respect to the panel decision on rehearing, the appellant is also filing a petition requiring the panel to provide a copy of that dictionary definition. The petition will be separately filed from this request for rehearing.

The 5 enumerated legal errors are specified in sections 1-5 below.

II. POINTS BELIEVED TO HAVE BEEN MISAPPREHENDED OR OVERLOOKED BY THE BOARD

1. APPLICATION OF INCORRECT STANDARD OF REVIEW

First, the decision misapprehends the law by apparently placing the burden of showing that *the examiner erred* in the appellant, and deciding *whether the examiner erred*, instead of, whether *the rejection* was in error.

Specifically, the statement of the issues appearing in the opinion is "whether the examiner erred", which implies that the appellant has the burden of showing that the examiner erred, and which colors the remainder of the decision. The issue is not "whether the examiner erred", and the appellant has not duty to identify how the examiner erred. Instead, the panel must "review[] the obviousness rejection for error based upon the issues identified by appellant, and in light of the arguments and evidence produced thereon". Ex parte Frye, Docket No. 2009-006013 in Application 10/790,923 (Bd. Pat. App. Int. Feb. 26, 2010) (Precedential) (expanded panel, per curiam), which is BPAI precedential case law binding this panel. That decision is posted on the USPTO web site at: <http://www.uspto.gov/ip/boards/bpai/decisions/prec/fd09006013.pdf>. If the panel finds the rejection is in error, the panel must reverse.

Thus, the decision imposes an improper standard of review by incorrectly framing the issue as whether the examiner erred instead of whether the rejections are in error. Therefore, a new decision complying with precedential case law on how the panel must go about deciding the appeal is required.

2. INCORRECT CONCLUSION AS TO THE LAW OF CLAIM CONSTRUCTION

Second, the decision misapprehends the law of claim construction by *ignoring appellants specification*, and as a result construing the claims in a manner *inconsistent* with the specification relative to the claim recitation "personal computer". The decision states in pertinent part that "The Specification does not define a personal computer. FF 01. Both the Appellants and the Examiner offer constructions for consideration, but absent further definition in the Specification, the construction is to be guided by how one of ordinary skill would have understood the term." However, all that FF 01 states "01. The disclosure contains no *lexicographic* definition of 'personal computer.'" Italics supplied for emphasis.

The panel and any reviewing Court should note that "*lexicographic*" means "of or relating to lexicography" and that in turn "*lexicography*" means the act of writing dictionaries". Cf. definitions obtained from <http://www.onelook.com/>. In other words, FF 01 is a fancy way of saying that the specification contains no dictionary definition of "personal computer". The appellant agrees that the specification contains no dictionary definition of "personal computer."

The decision commits fundamental error. The decision incorrectly relies upon FF 01 to conclude that "The Specification does not define a personal computer," when in fact all FF 01 states is that the specification contains no dictionary definition. The decision dependent conclusion is that, "absent further definition in the Specification, the construction is to be guided by how one of ordinary skill would have understood the term." There is no basis in the facts enumerated in the decision supporting the conclusion that the specification fails to define "personal computer". Hence, there is no basis in the decision to construe "personal computer" without reference to the specification. Hence, the decision is fundamentally flawed; it could not be affirmed upon review. In re Sang-Su Lee, 277 F.3d 1338 (Fed. Cir. 2002) ("Thus the Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency's conclusion."). Accordingly, this panel should reconsider.

The appellant points out that, despite the definition in the specification of "personal

computer" being central to the decision, the decision does not contain an assertion of fact stating that the specification contains no further definition of personal computer. The panel failure to expressly assert such a fact despite its centrality to the decision and despite what the appellant stated in the brief (brief section VIII.D is titled "Definition of "personal computer", refers to the specification, and spans brief pages 16-19), is tantamount to an admission by the panel that the specification does in fact further define "personal computer." At least, I think that is what any reviewing Court would find.

3. IMPROPER RELIANCE UPON AN *ALLEGED* DICTIONARY DEFINITION

Third, the decision improperly relies upon a dictionary definition to define "personal computer". Improper, in an evidentiary and due process sense, because the panel did not provide a copy of the evidence that the alleged definition is in fact a dictionary definition. And investigation indicates that the alleged definition is not what the dictionary relied upon actually states. And the differences are material. Specifically:

(1) FF 02 footnotes to note 2;

(2) footnote 2 reads "American Heritage Dictionary of the English Language, 4th ed. (2000)"; and

(3) FF 02 states that "The ordinary and customer meaning of 'personal computer' is a computer built around a microprocessor for use by an individual."

No copy of the portion of "American Heritage Dictionary of the English Language, 4th ed. (2000)" containing that definition was provided with the decision.

The undersigned does not have a copy of the cited dictionary and therefore cannot check the accuracy of the alleged definition.

Moreover, the decision did not place the alleged definition in quotation marks, leading to the inference that FF 02 is merely a paraphrase of the words of the actual dictionary definition.

Moreover, the alleged definition in FF 02 is inconsistent with the definition of "personal computer" available from the current online version of the American Heritage Dictionary of the English Language; the same dictionary, albeit a different edition, from the one identified in the footnote in the decision. Specifically, a search for "personal computer" definitions on <http://www.onelook.com/> results in the web page <http://www.onelook.com/?w=personal+computer&ls=a>, which web page lists 22 links for definitions of "personal computer". The second listed link has the descriptive text "personal

computer: American Heritage Dictionary of the English Language [home, info] " and links to the web page <http://education.yahoo.com/reference/dictionary/entry/personal%20computer> which shows the following definition for "personal computer":
personal computer

NOUN: Abbr. PC A computer built around a microprocessor for use by an individual, *as in an office or at home or school*. [Italics add to emphasis the difference from the definition asserted in FF 02 in the decision.]

Accordingly, the current online version of the same dictionary (American Heritage Dictionary of the English Language) relied upon in the decision for a definition of "personal computer" provides a different and clearly more narrow definition than the one allegedly cited in the decision. Accordingly, the accuracy of the definition in FF 02 is clearly suspect. The appellant requests that the panel provide a copy of the alleged dictionary definition pages identified in footnote 2, when issuing its decision on rehearing.

The principle "*inclusio unius est exclusio alterius*" is a well known principle of statutory construction, and there is no reason it is not equally applicable to dictionary definitions. Cf. Reflectone, Inc. v. Dalton, 60 F.3d 1572, 1576; 1995 U.S. App. LEXIS 20044; 40 Cont. Cas. Fed. (CCH) P76,803 (Fed. Cir. 1995). ("The inclusion of only one exception to the definition of "claim" - - undisputed, routine requests - - implies the exclusion of any others. See United States v. Koonce, 991 F.2d 693, 698 (11th Cir. 1993) (applying canon of statutory construction *inclusio unius est exclusio alterius*).") Hence, the "*as in an office or at home or school*" portion of this definition enumerates the examples indicating limitation to the definition of "personal computer."

If the claims were construed based upon the current online version of the American Heritage Dictionary of the English Language, for the definition of "personal computer", instead of the definition asserted in FF02, the decision on appeal would be different, and all rejections would (in the undersigned's opinion) be reversed. Hence, this apparent legal error is not harmless. This is because, in contrast with the definition presented in FF 02, the definition of a personal computer in the online version of American Heritage Dictionary of the English Language, noted above, connotes two features lacking from Nichtberger's CDR 20. Specifically, the "*as in an office or at home or school*" qualification in the online definition connotes (1) a computer capable of being programmed for the types of tasks performed "in an office or at home or school", such as a computer storing utility programs like word processors, spread sheets, and

internet browsers and (2) a computer small enough to be portable by a person between home or school or office.

Nichtberger does not disclose that its CDR 20 has such general programmability and Nichtberger does not disclose its CDR 20 is of a size that would be portable by a person between home or school or office, or useable even if ported.

Nichtberger discloses its CDR 20 is for a specific purpose, interacting to associate coupon offers with a consumer, and providing it with general programmability to the consumer would be inconsistent with that function both for system resource considerations and also user interaction/queuing and timing, considerations. Thus, Nichtberger's CDR 20 does not inherently have the general programmability of a personal computer.

The "as in an office or at home or school" qualification in the online definition indicates a degree of portability. One cannot (or at least the common understanding would have been that one should not) leave a personal computer at school, which means that the personal computer implies a size and portability limit. In contrast, Nichtberger's sole embodiment describing its CDR 20 is a structure in which an adult can stand, 5 feet tall. (Nichtberger states that: "As one example, the CDR unit 20 may comprise a five foot high metal enclosure, on the front panel of which are mounted a color video monitor 88 (FIG. 5) with a touch screen sensor 90, a magnetic stripe card reader 92 and a coupon selection list printer 94, all within easy reach of a standing adult." Nichtberger gives no other examples.). Nichtberger's CDR 20 cannot be considered a small digital computer in this sense, since Nichtberger's only physical embodiment is one in which an adult can stand, and is 5 feet tall. Accordingly, there is a significant difference between the FF 02 definition of "personal computer" and the publicly available definition of "personal computer" from the current online version of the same dictionary to which the definition in FF 02 derives. Significant to the extent of being dispositive, - even *assuming arguendo* that the previously discussed error in claim construction was harmless. (*In re Chapman*, Docket No. 2009-1270 __ F.3d __ (Fed. Cir. Feb. 24, 2010), noting that the harmless error rule applies to review of BPAI decisions.)

4. ADJUDICATION NOT IN COMPLIANCE WITH PRECEDENTIAL LEGAL REQUIREMENTS

Fourth, the decision misapprehends its duty by *not addressing on the record the appellants points raised in the brief regarding the specification's meaning of a "personal*

computer". As such, the decision either overlooked the brief or misapprehended its duty. Its duty is reiterated in Ex parte Frye, supra, which states in relevant part that:

The panel then reviews the obviousness rejection for error based upon the issues identified by appellant, and in light of the ***arguments and evidence produced thereon***. See *Oetiker*, 977 F.2d at 1445 ("In reviewing the examiner's decision on appeal, the Board must necessarily weigh all of the evidence and argument.") (emphasis added) *** Specifically, the Board reviews the particular finding(s) contested by an appellant anew in light of all the evidence and argument on that issue. [Italic and bolded added to emphasize the relevant requirement; underlining from original.]

On this point, all the decision states with respect to the meaning of "personal computer", and the 4 pages of reasoning in the brief showing how the specification defines "personal computer", is that:

Appellants and the Examiner *offer constructions for consideration*, but *absent further definition in the Specification*, the construction is to be guided by how one of ordinary skill would have understood the term. [Italics added to identify the relevant point.]

Thus, the decision admitted that the appellant offered construction for consideration, but failed on the record to consider the appellant's "argument on that issue"; certainly nothing in the opinion addresses the many points raised in the brief citing to the specification in support of a conclusion that the claimed personal computer was not something that read on Nichtberger's CDR 20. As noted in the brief at pages 18-19, after several pages of analysis, "From all of the foregoing, it is clear that the claimed personal computer means a computer personal to the consumer and that is capable of browsing the World Wide Web and sending and receiving emails. No element disclosed in Nichtberger has those capabilities and features."

To belabor the point a bit further, the record contains no evidence that the panel actually considered the arguments put forward in the brief regarding the meaning of "personal computer" and no evidence that the panel actually considered the facts asserted regarding what the specification teaches as to the limitations applying to the meaning of "personal computer" in the

claims. Accordingly, your reviewing Court would have no basis on which to affirm your decision to reject any claim. and would therefore reverse. See, In re Sang-Su Lee, supra.

5. INCORRECT CONCLUSION OF LAW, RELYING UPON ERRORS 1-4, IN CONCLUDING THAT THE CLAIMED "PERSONAL COMPUTER"

Fifth, if the panel had applied the proper law of claim construction, it would have construed the claimed "personal computer" as distinct from what Nichtberger discloses and reversed all rejections. The panel must construe the claims consistent with the specification:

However, this court has consistently taken the tack that claims yet unpatented are to be given the broadest reasonable interpretation consistent with the specification during the examination of a patent application since the applicant may then amend his claims, the thought being to reduce the possibility that, after the patent is granted, the claims may be interpreted as giving broader coverage than is justified. 31 In re Sweet, 393 F.2d 837, 157 USPQ 495 (1968); In re Soderquist, 326 F.2d 1016, 140 USPQ 387 (1964); In re Tibbals, 316 F.2d 955, 137 USPQ 565 (1963); In re Henatsch, 298 F.2d 954, 132 USPQ 445 (1962); In re Lundberg, 244 F.2d 543, 113 USPQ 530 (1957); In re Kebrich, 201 F.2d 951, 96 USPQ 411 (1953). We are not persuaded by any sound reason why, at any time before the patent is granted, an applicant should have limitations of the specification read into a claim where no express statement of the limitation is included in the claim. [In re Prater 415 F.2d 1393, 1404-5, 162 USPQ 541, 550-51 (CCPA 1969).

The CAFC has repeatedly addressed the issue of the requirement that the PTO's claim construction not be unreasonably broad, most recently this April, in In re Suitco Surface, Inc., where it stated that:

The PTO's construction here, though certainly broad, is unreasonably broad. The broadest-construction rubric coupled with the term "comprising" does not give the PTO an unfettered license to interpret claims to embrace anything remotely related to the claimed invention. Rather, claims should always be read in light of the specification and teachings in the underlying patent. See,

Schriber-Schroth Co. v. Cleveland Trust Co., 311 U.S. 211, 217 (1940) (“The claims of a patent are always to be read or interpreted in light of its specifications.”). In that vein, the express language of the claim and the specification require the finishing material to be the top and final layer on the surface being finished. See, e.g., ’514 patent, col.1 ll.15-20 (“The present invention is directed generally to a material and method for quickly and easily producing a transparent wear resistant finish on a smooth flat surface subject to wear and more particularly to a material and method for finishing a floor . . .”). The PTO’s proffered construction therefore fails. [In re Suitco Surface, Inc., Docket No. 2009-1418, ___ F.3d ___ (Fed. Cir. 14, 2010).].

In In re Suitco Surface, Inc., the CAFC stated that:

The express language of the claims requires a “material for finishing the top surface of the floor.” ’514 patent col.7 ll.67-68 (emphases added). A material cannot be finishing any surface unless it is the final layer on that surface. Otherwise, the material would not be “finishing” the surface in any meaningful sense of the word. The PTO’s proffered construction ignores this reality by allowing the finishing material to fall anywhere above the surface being finished regardless of whether it actually “finishes” the surface.

The CAFC reversed the BPAI claim construction as inconsistent with the “material for finishing” limitation, as clarified by the specification, stating:

When read in the appropriate context of the claim language and specification, the broadest reasonable construction is clear: the phrase “material for finishing the top surface of the floor” refers to a clear, uniform layer on the top surface of a floor that is the final treatment or coating of a surface. It is not any intermediate, temporary, or transitional layer.

This case clearly disposes of the “lexicographic” only, argument, implied in your decision; no lexicographic (dictionary) definition is required to limit the meaning of claim terms; only their consistency within the specification is required.

The instant appeal is in some respects analogous to the decision in In re Am. Acad. of Sci. Tech. Ctr., 367 F.3d 1359 (Fed. Cir. 2004). Both that case and this appeal dealt with the meaning of a computer; a "personal computer" in this case and a "user computer" in that case. There, the Court stated that:

American Academy first argues that the term "user computer" should be limited in the '989 patent to refer only to single-user computers. Although the claim does not contain words of restriction that would suggest that narrow construction, American Academy argues that the specification makes clear that the claim language should be given an interpretation narrower than the ordinary meaning of the claim language would suggest. This court has recognized that a patentee "may demonstrate an intent to deviate from the ordinary and accustomed meaning of a claim term by including in the specification expressions of manifest exclusion or restriction, representing a clear disavowal of claim scope." Teleflex, Inc. v. Ficosa N. Am. Corp., 299 F.3d 1313, 1325 (Fed. Cir. 2002); accord Alloc, Inc. v. ITC, 342 F.3d 1361, 1368 (Fed. Cir. 2003) ("A patent applicant may consistently and clearly use a term in a manner either more or less expansive than its general usage in the relevant art, thereby expanding or limiting the scope of the term in the context of the patent claims."); SciMed Life Sys., Inc. v. Advanced Cardiovascular Sys., Inc., 242 F.3d 1337, 1343-44 (Fed. Cir. 2001).

The Background of the Invention thus highlights the problems inherent in performing all the processing necessary to run multiple user applications at a central computer, whether that computer includes only one very expensive processor or several less expensive processors consuming valuable computing resources talking to one another. The specification does not, however, disclaim the networking of mainframes to a central computer that is devoted to database access. To the contrary, the Background of the Invention appears to allow a configuration in which multiple user applications are run separately on several mainframe computers, which communicate with a database computer that is dedicated to the functions of storing and retrieving data. In such a case, several less expensive mainframe computers could be used to manage the processing of an increasing number of user applications while the overhead associated with

communication among processors would be limited to communications related to the storage and retrieval of data.

The CAFC affirmed because the specification was inconsistent on limiting the meaning of "user computer". The Court concluded that:

We agree with the Board that the description in the specification would not preclude a mainframe or a minicomputer from serving as the "user computer" of the invention. In general, the specification distinguishes a user computer from a data center computer in terms of function. Although some of the language of the specification, when viewed in isolation, might lead a reader to conclude that the term "user computer" is meant to refer to a computer that serves only a single user, the specification as a whole suggests a construction that is not so narrow. Instead, the specification indicates that the invention is intended to reach "a variety of configurations" including those in which the "user" is not a person, but is another device or machine. Thus, in light of the description in the specification, a construction of "user computer" that includes multi-user computers, such as mainframes or minicomputers, is not unreasonably broad.

As noted in the decision, the statement Background section of a patent of the problems a limitations overcome by the invention is relevant to defining terms in the claims. Unlike in In re Am. Acad. of Sci. Tech Ctr., however, our specification is consistent with the meaning of a user computer that is distinct from the CDR 20 of Nichtberger, as to size, location, networkability, and programmability. Accordingly, the ignorance by panel decision in this case of the specification and of the reasoning in the brief as to the definition of "personal computer" in the specification, are legally improper, not harmless error, and for the reasons noted above, would be reversed on appeal. Accordingly, the appellants request rehearing and reversal of all rejections.

5/14/2010

DATE

Respectfully Submitted,
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RAN/GP

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